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UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : June 20, 2005
LISZIEWICZ, et al. : Atty Docket No. RGT 9771
10/081,922 : Group 1632
Filed: 15 September 1998 : Examiner: Wilson

**For: Method of Delivering Genes into Antigen
Presenting Cells of the Skin**

Mail Stop: Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450
Attn: Alesia M. Brown

Phone (571) 272-3205 FAX (703) 872-9306¹

PETITION TO REVIVE**37 CFR 1.137(a) or (b)**

In response to a Decision on Petition bearing a mail date of June 16, 2005 that dismisses the applicants' petition to revive under 37 CFR 1.137(a) the applicants renew their petition under 27 CFR 1.137(a), and in the alternative, petition under 37 CFR 1.137(b) to revive the referenced case as unintentionally abandoned. The applicants filed a Petition to Revive, Renewed Request for Meeting, Response, and RCE on April 13, 2005. In response to that filing, an Interview was held June 7, 2005, and a 28-page Amendment was filed June 13, 2005.

This petition is accompanied by the fee set forth in 37 CFR §1.17(m). The Commissioner is authorized to charge any fees due, or credit any overage, to Deposit Account No. 50-0855. A credit card payment form is included to cover the petition fee.

The entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was, in Counsel's view, unavoidable, or at least unintentional.

The present case is a division of USPN 6,420,176. It was filed February 21, 2002 with a Preliminary Amendment that included the cumulated changes made to the parent patent and its corresponding PCT case, and divisional Claims clearly corresponding to the original Class II of the parent application, amended only for the purpose of placing them in

¹ This letter is being forwarded to the USPTO via the official fax number by Valerie E. Looper on June 20, 2005, signed *Valerie E. Looper*

* Received: 4 pages. * Did not receive: page 5/5. CH

the format previously favored by the Examiner. The claims in this case have been in condition for allowance since the date of filing. The specification of the new application was re-paginated, because the case is old and dates back through two OS programs and at least 4 word processors. As a result, searching the document for a page cite had become increasingly difficult. The preliminary amendment noted that the divisional application had been repaginated, and cited to the original application for support for the amendments.

An Office Action was issued March 10, 2004, citing prior art that had been overcome in the parent case and formal objections. Each of the Examiner's concerns was fully answered in detail in an amendment filed June 7, 2004. Among other things, the Examiner's new matter objections were answered in the 27-page document by citation to the parent patent, and a specific citation to the actual phrases in the claims from the parent application. The Examiner issued a Final Rejection bearing a mail date of September 22, 2004 that was non-responsive to the amendment.

On October 21, 2004, the applicants filed a Special Procedures Submission requesting a meeting to discuss the defective Final Rejection. For the purpose of facilitating the meeting, the applicants enclosed mark-up copies of the Office Action of September 22, 2004, the underlying Amendment, and the parent patent, showing conclusively that there was no new matter in the divisional application. The "new matter" rejections were cited as examples of problems with the Final Rejection, but they were not the only serious flaws in the Final Rejection. Other flaws included cut-and-pasted sections that were not applicable, more than one statement that the applicants had not dealt with items that had been answered, and a 102 rejection that was not withdrawn, despite an amendment incorporating all the limitations of a claim that had not been subject to the rejection.

The applicant followed up with calls in November in order to set up a meeting date, and was told by the Examiner that the Office Action was going to be withdrawn, and a new one issued. This has happened before, in counsel's experience with this group, and possibly due to the extraordinary length of the office actions involved, has taken months. In a phone message to Counsel and in at least one telephone conversation, the Examiner mentioned that the header from the preliminary amendment "Division of appln...." had been mistakenly used on the June 7 Amendment. On this basis, Counsel had reason to believe the Examiner had all the documents in hand, and intended to do as he said.

Counsel reasonably relied upon this representation by the Examiner. The Office Action, when it came, was a Notice of Abandonment, allegedly for the Applicant's failure to respond. The Office Action, bearing a mail date of April 4, 2005, withdrew one new matter objection, but did not cure the defects in the Final Rejection at least because it maintained new matter rejections that are insupportable, as pointed out in detail in an Amendment filed

June 7, 2004, and highlighted in the Special Procedures Submission filed October 21, 2001. The Notice of Abandonment made much of a confusing header on the June 7 Amendment and also states that the Examiner did not find the request for interview until April 1. This makes no sense, because counsel was following up by phone with the Examiner to set up meeting dates for December, and the Examiner was complaining about the header.

Counsel for the applicant notes that the Examiner acknowledges picking up the case again on April 1, 2005, and calling Counsel's office. Counsel was traveling at that time, when construction at the office site caused a series of power outages that disabled the phone message system. At any rate, Counsel was surprised by the Notice of Abandonment in place of a new Office Action.

An initial reply to the Notice of Abandonment and Renewed Request for Meeting was faxed pursuant to the Notice of Abandonment to "the official fax number" -- (571) 273-8300 found in that paper upon receipt of that paper on April 6, 2005. No confirmation fax was received, and from a series of follow-up phone calls, it appears the fax has not been received by the USPTO. No reply to the final phone call to (703) 308-9150 ext. 152 has been received to date. Counsel followed up with a Petition to Revive, Renewed Request for Meeting, Response to Office Action 04/04/2005 and an RCE on April 13th. Counsel has followed up with multiple telephone calls to set up an Interview, which was held June 7, 2005. At that time, agreement was reached with respect to the "new matter" objections. Counsel was prepared to deal with the prior art rejections then, but the Examiner had time constraints, and so the resulting 28-page amendment with 3 journal articles appended was filed without further discussion on June 13, 2005.

1. Lack of Reply

The applicants' original petition to revive was rejected in part because the Office of Petitions had held that the required reply was lacking. The applicants submit that the appropriate reply to the outstanding objections as written had been submitted June 7th, and again October 21st, 2004. In those replies, the applicant pointed out the specific language in the parent application that had been rejected as "new matter." What the Examiner actually wanted, it turns out, were citations to the printed copy of the divisional application. The true basis of the objections was lack of support in the present specification, not new matter in the specification (that had not been in the parent). Once this was clarified, it was relatively straightforward to offer the Examiner the cites he wanted in the interview, and then follow up with a written reply. Without this clarification, another "reply" would have been pointless.

2. Unavoidable Delay


The Decision on Petition of June 16, 2005 also suggests that the Commissioner is not satisfied that the delay was unavoidable because the Notice of Abandonment states that submission of a previously submitted amendment and a request for an interview did not constitute a bona fide reply to the final Office action. However, the applicants point out that whole purpose of requesting an interview was to find out why the correct and full responses already submitted had not been accepted. Counsel had expected to have the meeting, get the information, and then file a written response, and proceeded in a timely fashion toward that result. The meeting, and consequently the written reply, was forestalled by the Examiner's representation that a new Office Action would issue. At the time the applicants' first petition to revive was filed, the applicants did not know that the "new matter" rejections were actually lack of support objections, and that the citations the Examiner was requesting were from a different document. Once the interview was had, then Counsel could proceed with a response that addresses the Examiner's real concern. In Counsel's view, the delay was unavoidable.

3. Alternative Venue

In the alternative, the applicants petition under 37 CFR 1.137(b), that the application be revived as unintentionally abandoned. As discussed at paragraph 2, above, Counsel proceeded in a logical and timely fashion in an attempt to find out why the appropriate and fully replies already on file had not been accepted. Once that information was available, Counsel acted in a timely fashion to file a new reply.

This petition is being filed the day the previous decision on petition was received, after both the interview was granted to the applicants and a reply filed. Clarification of the outstanding rejections (and therefore, the interview) was necessary because the Examiner was asking for the wrong set of information. With clarification in hand, the reply was filed promptly, as was this petition.

Respectfully Submitted,


Valerie E. Looper
Registration No. 33,007

The Law Offices of
Valerie E. Looper
11726 Lightfall Court
Columbia, Maryland 21044
Telephone: (410) 715 - 5771